

REMARKS

Request for Continued Examination

A Request for Continued Examination (RCE) under 37 C.F.R. 1.114 is submitted herewith.

Petition for Extension of Time

A Petition for Extension of Time Under 37 C.F.R. 1.136(a) for a three-month extension of time is submitted herewith.

Payment of Fees

Checks in the amount of \$770 and \$420 were previously submitted to cover the cost of the RCE and a two-month extension of time. A check in the amount of \$530.00 is submitted herewith to cover the cost of the difference between the paid two-month extension of time and the three-month extension of time. Please charge any insufficiency of payment or credit any overpayment to Deposit Account No. 02-1818.

Summary Status of the Case

In an Office Action dated May 28, 2003, all the then-pending claims were rejected and the action was made final. In addition, the drawings were objected to on the basis that a feature of the invention specified in the claims was not shown in the drawings.

A first reply in the form of a Response to Office Action was filed on July 28, 2003. In an effort to place the case in condition for allowance, a number of claims were cancelled without prejudice. The objection to the drawing was rendered moot by canceling the claim [claim 13] which included the feature alleged to be not shown in the drawing.

In an Advisory Action dated August 11, 2003, the proposed amendments were entered and all the then-pending claims were rejected. Claims 38-46 have been reinstated. They were formerly claims 23-27 and 29-32.

Current Status of the Claims

Claims 1, 3-12 and 38-46 are pending and subject to consideration. Claims 38-46 have been reinstated. They were formerly claims 23-27 and 29-32. Claims 14-22 and 33-37 are pending but withdrawn from consideration.

Claim Rejections

The claim rejections are as set forth in the Office Action dated May 28, 2003. Each of these grounds for rejection are addressed in detail below.

Section 112 Rejection

Then pending Claim 25 (which has been reinstated as Claim 40) was rejected under 35 U.S.C. § 112, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the phrase "the display device" was said not to have a proper antecedent basis. A suggestion to make this claim feature read as "the at least one of the display devices" has been accepted and incorporated in pending Claim 40.

Section 103 Rejections

All the claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,813,914 (McKay, et al.) in view of U.S. Patent No. 5,335,604 (Drabczyk). In addition to reliance on these references, administrative notice was taken of the following facts: a laminate may be applied to a substrate as a sheet or as a plurality of sheets (cited evidence reference was U.S. Patent No. 5,244,267 (Fossier, Jr., et al.)); an adhesive may be used to bond to a substrate (cited evidence reference was U.S. Patent No. 6,053,585 (Osen)); and differently sized cabinets may be used to form a modular cabinet structure (cited reference was U.S. Patent No. 6,267,462 (Krause, et al.)). Arguments as to obviousness of certain elements of the claimed invention were made based upon "the general skill of a worker in the art."

Summary of the Invention

Slot machines are typically very well built with long lasting components. As a result, during their lifetime, many slot machines are converted from one game theme to another game theme, i.e., a "Double Diamond" theme game might be converted to a "Red, White & Blue" theme game. The purpose behind most conversions is to increase machine earnings by switching from a theme which is no longer attracting players and has reduced earnings to a theme which will attract players and increase earnings. In making these conversions it is typical to change the glass and reel strips. In addition, software and hardware changes or upgrades may be made. The

ability to make these conversions easily and without removing the machine from a game room floor is very important to gaming establishment operators.

In order to allow for these conversions, most modern slot machines are sold with little or no decoration or ornamentation on their sides. Indeed, the sides of most slot machines are provided with a uniform, neutral finish such as plain black, white or brown metal or wood panels. It would be preferable if the sides of the slot machines could be provided with ornamentation or decoration in keeping with, or to complement, the game theme. However, to do so, means must be provided for changing the ornamentation or decoration on the side if the game theme is changed.

The present invention fulfills this need. The present invention provides slot machines with laminated panels which can be decorated in accordance with the game theme and are removable so that they can be changed when the machine is converted from one game them to another.

Additionally, the present invention allows for easy upgrade of the machines due to its component nature and its accommodation of different sized displays.

Further, the present invention facilitates the manufacture of slot machines by allowing for the increased standardization of components along with the increased customization of the machines to the theme of the incorporated game.

The prior art rejection is based upon a combination of references, general skill and administrative notice from unrelated fields. With regard to the references, McKay, et al. relates to gaming machines and Drabczyk relates to office furniture. No teaching, suggestion or motivation for combining these references has been identified. In order to combine references, it is necessary to identify some teaching, suggestion or motivation for doing so in the prior art. In re Mayne, 104 F.3d 1339, 1342, 41 USPQ 2d 1451, 1454 (Fed. Cir. 1997) ("When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion to combine references or make the modification"). See also In re Dembicziak, 175 F.3d 994, 999, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references"); In re Dance, 160 F.3d 1339, 1343, 48 USPQ 2d 1635, 1637 (Fed. Cir. 1998).
[Handwritten mark: A large bracket covers the text from "In re Mayne" to "In re Dance". To the right of the bracket, there is handwritten text "In re" followed by a signature.]

Cir. 1998) ("To establish a *prima facie* case of obviousness based on a combination of content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant."). The combinations of references, general skill and administrative notice made in the Office Action is improper and based on impermissible hindsight.

Moreover, even the improper combination of references does not teach the claimed invention. McKay, et al. does not teach either (1) a display cabinet removably connected to the component cabinet or (2) side panels removably connected to opposite sides of the component cabinet and the display cabinet. McKay, et al. discloses a slant-top video gaming device with a unitary component and display cabinet. McKay, et al. does not teach a removably connected display cabinet. In Figure 2, the top cap assembly of the gaming device is shown as removed from the unitary component and display cabinet. See also the "Brief Description of the Drawings" at column 3, lines 39 which states: "Fig. 2 is an elevated perspective view of a gaming device showing a top cap assembly removed therefrom." [Emphasis added] However, McKay, et al. does not teach or suggest removal of the top cap assembly once it is attached to the gaming device cabinet. In fact, McKay, et al. teaches away from such removal by disclosing and claiming means for changing the glass panel in the top cap assembly when the gaming device undergoes changeover from one game to another.

There is no support for the contention that McKay, et al. teaches a cabinet with removably connected side panels. Two of the primary objects of McKay, et al. are to "provide security with respect to areas that are to be sequestered from personnel having different job descriptions" (column 2, lines 59-61) and to "make[s] unauthorized access to various areas of the cabinet less likely and more difficult" (column 2, lines 63-65). The purported side panels of McKay, et al. are not removably connected to the sides of the cabinet. They are the sides of the cabinets. If they were removable, it would directly contradict McKay, et al.'s teachings regarding the importance of making the cabinet and its various components secure.

With specific regard to claim 1 and McKay, et al., the primary reference relied on in the Office Action, Applicants submit the following claim chart:

Claim 1

U.S. Patent No. 5,813,914

(Mc Kay, et al.)

A gaming device

Yes.

- a gaming device.

a component cabinet;

No.

- unitary component and display cabinet.

a display cabinet removably connected to said component cabinet;

No.

- unitary component and display cabinet.

a display device included in said display cabinet and operable with a processor and at least one player input device to enable a player to play a game upon a wager by the player; and

No.

- The top cap assembly includes a removable piece of glass. This piece of glass is not operable with a processor or a player input device. The video display of McKay, et al. is in the unitary component and display cabinet.

side panels removably connected to opposite sides of said component cabinet and said display cabinet, wherein each side panel includes a substrate and a decorative layer connected to the substrate.

No.

- no removable side panels;
- no side panels or any other element with a substrate and decorative layer.

Drabczyk does not teach the elements of the claimed invention not taught by McKay, et al. The rejection of the claim 1 is based on the premise that McKay, et al. discloses all the claimed features of the invention of claim 1 (the component cabinet, the display cabinet and display device elements) except side panels including a substrate with a decorative panel and that Drabczyk discloses these features of claim 1. As shown in the claim chart provided above, this is not true.

Conclusion

The rejection of the claims should be withdrawn. The combination of references and administrative notice is based on a combination for which there is no teaching or suggestion in the prior art and which was assembled using improper hindsight using the claimed invention as a guide. Moreover, the prior art does not teach all the claimed elements of the invention.

An early indication of allowability is solicited. If the Examiner has any questions related to this application, Applicants respectfully request that the Examiner contact the undersigned attorney.

Respectfully submitted,

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